REMARKS/ARGUMENTS

By this Amendment, Claims 1 and 49 - 61 remain in this application, with Claim 1 having been amended and Claim 58 is being held withdraw.

Favorable reconsideration is respectfully requested in view of the foregoing amendments and the following remarks.

The only independent claim in this case, i.e., Claim 1, was rejected as being obvious over U.S. Patent No. 4,864,740 (Oakley), in view of U.S. Patent Nos. 5,388,349 (Ogden), 5,675,914 (Cintron) and 4,808,458 (Watt).

As amended Claim 1 is similar to Claim 1 as amended in the RCE except for some minor changes in language. In particular, Claim 1 now calls for a shoe insert having the following combined features: (1) a synthetic non-woven fabric layer, (2) with the synthetic fabric layer containing surface fibers oriented in a vertical direction and having an inside portion and an outside portion, (3) with the synthetic non-woven fabric layer having a coefficient of friction along the inside portion between about 0.52 and 0.82; and (4) with the insert having a non-slip surface disposed along the outside portion of the fabric layer, and (5) with the non-slip surface having a coefficient of friction that is greater than the coefficient of friction of the inside portion of the fabric. The combination of these features are not shown nor suggested in the cited prior art.

With regard to the rejection: on page 2 of the Office Action, the examiner states that the Ogden reference teaches adjusting the co-efficient of friction of a synthetic non-woven top surface of an insert to above 0.5. It is respectfully submitted that this conclusion regarding the teaching of

Ogden is erroneous, since Ogden is not a synthetic non-woven "**fabric**" having a top surface in accordance with the normal meaning of the term non-woven fabric. Rather, it is simply an extruded film or sheet. On page 3 of the Office Action, the examiner responds to the arguments that were made in the amendment of the applicants' Request for Continued Examination by stating that "in response to Applicant's argument that the material layer of Ogden is not a synthetic non-woven, layer 4 of Ogden is synthetic (thermoplastic) material and it is non-woven (non-woven, it is extruded in sheet form, column 6, line 52).

Initially it should be pointed out that there is no layer 4 in the structure of the Ogden patent. Putting that aside, and quite significantly, the Office Action glosses over the word "fabric" that is in the claim. In particular, while the top layer 20 of the Ogden reference may be a non-woven in a general sense, it is certainly not a non-woven fabric. Thus, it is respectfully submitted that the combination of Ogden and Oakley is improper. Further still neither reference teaches the specific coefficient of friction range claimed. In this regard, while Ogden mentions that for certain activities the coefficient of friction can be "increased to a level on the order of about 0.45 to 0.5" (See Col. 11, lines 43-46) and hints that there may be uses with coefficients of friction higher (See Col. 11, lines 50 -57), nowhere does Ogden disclose the specific range being claimed, namely, 0.52 to 0.82. As discussed in the amendment portion of the RCE while discovering the optimum or workable ranges may involve only routine skill in the art in many cases, there would be no incentive to attempt such an undertaking in this case.

The tertiary reference, i.e., the patent to Cintron, fails to make up for the deficiencies of the primary and secondary references since it discloses use of suede for the inside (upper) surface of an insert for footwear. Claim 1 as presented herein calls for a synthetic fabric. Clearly, suede is not a synthetic fabric. Thus, there would be no reason to go to the Cintron patent for its teachings to modify the insert of Oakley.

The quaternary reference, i.e., the patent to Watt fails to make up for the deficiencies of the primary, secondary and tertiary references, since it merely discloses a suede-like fabric and method of making it. The Watt patent doesn't disclose the use of a synthetic material for the top surface of an insert for footwear, let alone one having the features called for in Claim 1, i.e., a synthetic non-woven fabric layer having a coefficient of friction between about 0.52 and 0.82. Thus, one would not go to the Watt patent for a teaching to use of such a fabric as the top surface of an insert for footwear.

Further still, Claim 1 calls for the coefficient of friction of the outside portion of the fabric layer to have a coefficient of friction that is greater than the coefficient of friction of the inside portion of the fabric. These combined features are not shown nor suggested by the patents to Oakley, Ogden, Cintron and Watt.

As stated before, It is respectfully submitted that even if the four cited references did disclose all of the features now set forth in amended Claim 1, their combination would still be untenable as a valid rejection of Claim 1. In particular, any suggestion of obviousness could only be the result if

the PTO reads the subject matter of the present invention into the Ogden reference (and the other cited art as well), where no such disclosure exists

For at least the reasons set forth above, it is respectfully submitted that the above-identified application is in condition for allowance. Favorable reconsideration and prompt allowance of the claims are respectfully requested.

Should the Examiner believe that anything further is desirable in order to place the application in even better condition for allowance, the Examiner is invited to contact Applicants' undersigned attorney at the telephone number listed below.

Respectfully submitted,

CAESAR, RIVISE, BERNSTEIN,
COHEN & POKOTILOW, LTD.

July 26, 2004

By _____

Barry A. Stein
Registration No. 25,257
Customer No. 03000
(215) 567-2010
Attorneys for Applicants

Please charge or credit our Account No. 03-0075 as necessary to effect entry and/or ensure consideration of this submission.